



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,344	07/16/1999	MICHAEL D. ELLIS	UV-99	5021

7590 07/09/2004

G VICTOR TREYZ
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK, NY 100201104

EXAMINER

HUYNH, SON P

ART UNIT	PAPER NUMBER
----------	--------------

2611

12

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/354,344

Applicant(s)

ELLIS ET AL.

Examiner

Son P Huynh

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-177 is/are pending in the application.
- 4a) Of the above claim(s) 1-39, 50-98, 109-152 and 163-167 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-49, 99-108, 153-162 and 168-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 40-49, 99-108, 153-162 in the reply filed on 4/12/2004 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities: Application serial No. on page 19, line 15 is missing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 40-45, 49, 99-104, 108, 159-162 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 40, line 27 and claim 49, line 24, the term "provide the program" is unclear. The examiner interprets it as – provide the television program. Appropriate correction is required.

Claims 99, 108, 159, 162 recite the limitation "the user" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 46-47, 49, 99-106, 108, 153-160 and 162 are rejected under 35 U.S.C. 102(e) as being anticipated by Croy et al. (US 6,509,908).

Regarding claim 40, Croy teaches a system for remotely recording television program comprising:

interactive television program guide equipment (base station 100, television 140, VCR 142, etc. figure 1) on which a local interactive television program guide is implemented (program guide implemented at the base station 100 and TV 140 – col. 9, line 3+),

wherein the interactive television program guide equipment includes user television equipment (e.g., VCR, TV) located within a user's home (col. 9, line 3+);
a remote program guide access device (200-figure 2) located outside of the user's home (the remote device 200 or personal navigation (PN) can be terminal for information services, portable intelligent phone, video phone, etc. col. 9, line 10+. The PN communicates with the base unit via RF, IR, UBS, Ethernet, etc. col. 4, line 15+. Inherently, the PN can be located outside of the user's home) on which a remote access interactive program guide is implemented (program guide implemented at PN – figures 12+), wherein the remote access interactive television program guide is configured to: provide the user with an opportunity to remotely select a television program for recording by the local interactive television program guide over a remote access link (the user selects a particular programming for recording using VCR or other recording means from the listing of programs presented to user on the screen using the PN-; user selection is provided to base station and VCR via remote access link between base station and the PN 200 -figures 1, 2, 23-24 and col. 4, lines 8-37; col. 17, line 9+); and remotely record the television program selected by the user over the remote access link with the remote access interactive television program guide (remotely record the television selected by the user on the VCR, in response to user selection received from remote access interactive program guide on remote device 100 via the network connect between remote device 200 and base station – col. 17, line 9+).

the local interactive television program guide is configured to provide the program (broadcast message, program data, etc. – col. 4, line 60+) to the remote access

interactive television program guide (figures 12+) over the remote access link with the local interactive television program guide (link between base station and remote device 200 or personal navigator (PN) –col. 4, line 10+).

Regarding claim 41, Croy teaches the remote access interactive program guide is configured to obtain directory information from the local interactive television program guide over the remote access link (obtaining information from base station over remote access link with the PN- figures 1-2 and col. 4, line 10+).

Regarding claim 42, Croy teaches the remote access interactive television program guide is configured to obtain video information from the local interactive television program guide over the remote access link (obtaining video information from base station over remote access link with the PN- figures 1-2, 12+ and col. 4, line 10+).

Regarding claim 43, Croy teaches the remote access interactive television program guide is configured to: provide the user with an opportunity to select a video for playback by the remote program guide access device with the remote access interactive television program guide (user using PN to select a program from the listing on the PN screen for playback – figure 22+);
remotely obtain the video selected by the user for playback from the local interactive television program guide over the remote access link (e.g. the VCR or TV obtains

selected program in response to request receive via the link between PN and the station – figures 22+ and col. 4, line 9+);

remotely playing the video for the user with the remote program guide access device (the selected program is played in response to user selection using the PN – col. 17, line 20+);

Regarding claim 44, Croy teaches the remote access interactive television program guide is configured to obtain audio information from the local interactive television program guide over the remote access link (figures 2, 39+ and col. 5, line 7+).

Regarding claim 45, Croy teaches the remote access interactive television program guide is configured to: provide the user with an opportunity to select audio (e.g. user selects MUSIC) for playback by the remote program guide access device with the remote access interactive television program guide (figure 39+);
remotely obtain the audio selected by the user for playback from the local interactive television program guide (e.g., base station) over the remote access link (obtaining selected audio for playback at the base station (col. 5, line 32+, figures 39+). As a result, the audio selected by the user using remote program guide access device (PN) is played for the user.

Regarding claim 46, Croy teaches a system for selecting programs over a remote access link (RF, IR, UBS, Ethernet, etc. – col. 4, lines 14-37) for recording comprising:

Art Unit: 2611

interactive television program guide equipment (base station 100, television 140, VCR 142, etc. figure 1) on which a local interactive television program guide is implemented (program guide implemented at the base station 100 and TV 140 – col. 9, line 3+), wherein the interactive television program guide equipment includes user television equipment (e.g., VCR, TV) located within a user's home (col. 9, line 3+); a remote program guide access device (200-figure 2) located outside of the user's home (the remote device 200 or personal navigation (PN) can be terminal for information services, portable intelligent phone, video phone, etc. col. 9, line 10+. The PN communicates with the base unit via RF, IR, UBS, Ethernet, etc. col. 4, line 15+. Inherently, the PN can be located outside of the user's home) on which a remote access interactive program guide is implemented (program guide implemented at PN – figures 12+), wherein the remote access interactive television program guide is configured to provide the user with an opportunity to remotely select a program for recording by the local interactive television program guide over a remote access link (the user selects a particular programming for recording using VCR or other recording means from the listing of programs presented to user on the screen using the PN- figures 23-24 and col. 17, line 9+); and the local interactive television program guide is configured to record the television program selected by the user with the interactive television program guide equipment (VCR or recording means is used to record the selected program- col. 17, line 9+).

Regarding claim 47, Croy teaches the local interactive television program guide is configured to record the television program selected by the user on the user television equipment (e.g. VCR – col. 17, line 9+).

Regarding claim 49, Croy teaches a system for selecting programs over a remote access link (RF, IR, UBS, Ethernet, etc. – col. 4, lines 14-37) for playing back (figure 52) comprising:

interactive television program guide equipment (base station 100, television 140, VCR 142, etc. figure 1) on which a local interactive television program guide is implemented (program guide implemented at the base station 100 and TV 140 – col. 9, line 3+),

wherein the interactive television program guide equipment includes user television equipment (e.g., VCR, TV) located within a user's home (col. 9, line 3+);

a remote program guide access device (200-figure 2) located outside of the user's home (the remote device 200 or personal navigation (PN) can be terminal for information services, portable intelligent phone, video phone, etc. col. 9, line 10+. The PN communicates with the base unit via RF, IR, UBS, Ethernet, etc. col. 4, line 15+.

Inherently, the PN can be located outside of the user's home) on which a remote access interactive program guide is implemented (program guide implemented at PN – figures 12+), wherein the remote access interactive television program guide is configured to: provide the user with an opportunity to remotely select a program for playing by the remote program guide access device from the local interactive television program guide (the user using the PN to select a particular programming from base station, VCR, or TV

for playing – figures 14+); as a result, the selected program is played in response to user selection received via network connect between base station and remote device 200;

the local interactive television program guide is configured to provide the program (broadcast message, program data, etc. – col. 4, line 60+) to the remote access interactive television program guide (figures 12+) over the remote access link with the local interactive television program guide (link between base station and remote device 200 or personal navigator (PN) –col. 4, line 10+).

Regarding claim 99, Croy teaches a method for remotely recording a television program, the method comprising:

providing the user with an opportunity to remotely select a television program for recording over a remote access link (link between base station and remote device 200 or PN using IR, RF, UBS, Ethernet, etc. – col. 4, line 10+) by a remote access interactive television program guide implemented on a remote program guide access device (program guide implemented on the PN-figure 12+) located outside of a user's home (remote device 200 or PN can be terminal for information services, portable intelligent phone, video phone, etc. – col. 9, line 7+. The PN communicates with base station using RF, UBS, Ethernet, etc. – col. 4, line 10+. Inherently, the PN can be located outside the user's home) from a local interactive television program guide implemented on interactive television program guide equipment having user television

Art Unit: 2611

equipment located within the user's home (program guide implemented on the base station having TV, VCR, etc. – figure 1); and
remotely recording the television program selected by the user over the remote access link with the remote access interactive television program guide (using the PN to select a particular programming displayed on program list to be recorded using VCR or recording means – col. 17, line 9+).

Regarding claim 100, Croy teaches obtaining directory information from the local interactive television program guide over the remote access link with the remote access interactive television program guide (obtaining information from base station over remote access link with the PN- figures 1-2 and col. 4, line 10+).

Regarding claim 101, Croy teaches obtaining video information from the local interactive television program guide over the remote access link with the remote access interactive television program guide (obtaining video information from base station over remote access link with the PN- figures 1-2, 12+ and col. 4, line 10+).

Regarding claim 102, Croy teaches providing the user with an opportunity to select a video for playback by the remote program guide access device with the remote access interactive television program guide (user using PN to select a program from the listing on the PN screen for playback – figure 22+);

remotely obtaining the video selected by the user for playback from the local interactive television program guide over the remote access link with the remote program guide access device (e.g. the VCR or TV obtains selected program in response to request receive via the link between PN and the station – figures 22+ and col. 4, line 9+);
remotely playing the video for the user with the remote program guide access device (the selected program is played in response to user selection using the PN – col. 17, line 20+);

Regarding claim 103, Croy teaches obtaining audio information from the local interactive television program guide over the remote access link with the remote access interactive television program guide (figures 2, 39+ and col. 5, line 7+).

Regarding claim 104, Croy teaches providing the user with an opportunity to select audio (e.g. user selects MUSIC) for playback by the remote program guide access device with the remote access interactive television program guide (figure 39+);
remotely obtaining the audio selected by the user for playback from the local interactive television program guide (e.g., base station) over the remote access link using the remote program guide access device (obtaining selected audio for playback at the base station (col. 5, line 32+, figures 39+). As a result, the audio selected by the user using remote program guide access device (PN) is played for the user.

Regarding claim 105, Croy teaches a method for remotely recording a television program over a remote access link (link between base station 100 and remote device 200 – figures 1-2), the method comprising:

providing a user with an opportunity to remotely select a television program for recording over a remote access link (link between base station and remote device 200 or PN using IR, RF, UBS, Ethernet, etc. – col. 4, line 10+) by a remote access interactive television program guide implemented on a remote program guide access device (program guide implemented on the PN-figure 12+) located outside of a user's home (remote device 200 or PN can be terminal for information services, portable intelligent phone, video phone, etc. – col. 9, line 7+. The PN communicates with base station using RF, UBS, Ethernet, etc. – col. 4, line 10+. Inherently, the PN can be located outside the user's home) from a local interactive television program guide implemented on interactive television program guide equipment having user television equipment located within the user's home (program guide implemented on the base station having TV, VCR, etc. – figure 1); and

recording the television program selected by the user with the remote access interactive television program guide (recording the selected program using VCR or recording means col. 17, line 9+).

Regarding claim 106, Croy teaches recording the program selected by the user with the local interactive television program guide on the interactive television program guide

Art Unit: 2611

equipment comprises recording the program on the user television equipment (e.g., VCR – figure 1 and col. 17, line 9+).

Regarding claim 108, Croy teaches a method for selecting programs over a remote access link (link between base station 100 and remote device 200 – figures 1-2) for playing back, the method comprising:

providing the user with an opportunity to remotely select a television program for playing with a remote access interactive television program guide implemented on a remote program guide access device (program guide implemented on the PN-figure 12+)

located outside of a user's home (remote device 200 or PN can be terminal for information services, portable intelligent phone, video phone, etc. – col. 9, line 7+. The PN communicates with base station using RF, UBS, Ethernet, etc. – col. 4, line 10+.

Inherently, the PN can be located outside the user's home) from a local interactive television program guide;

obtaining the television program from the local interactive television program guide implemented on interactive television program guide equipment having user television equipment located within the user's home with the remote access interactive program guide; (obtaining the television program selected by user, using remote device, from program guide implemented on the base station having TV, VCR, etc. – figures 1, 12+);
and

Art Unit: 2611

remotely playing the video for the user with the remote program guide access device (the selected program is played in response to user selection using the PN – col. 17, line 20+);

Regarding claims 153-160, 162, the limitations of the system as claimed correspond to the limitations of the method as claimed in claims 99-106, 108, and are analyzed as discussed with respect to the rejection of claims 99-106, 108.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 48, 107, 161, 168-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croy et al. (US 6,509,908).

Regarding claim 48, Croy teaches the system as discussed in the rejection of claim 46. However, Croy does not specifically disclose record the selected television program by the user at a television distribution facility. It is obvious to one of ordinary skill in the art

to record the selected program at a television distribution facility in order that multiple users can share the recorded program.

Regarding claims 107, 161, the limitations as claimed correspond to the limitations as claimed in claim 48, and are analyzed as discussed with respect to the rejection of claim 48.

Regarding claim 168, the limitations as claimed are directed toward embodying the method of claim 99 in "machine readable medium." Inherently, the television program is received before it is recorded. It would have been obvious to embody the procedures of Croy as discussed with respect to claim 99 in a "machine readable medium" in order that the instructions could be automatically performed by a processor.

Regarding claims 169-177, the limitations as claimed are directed toward embodying the method of claims 100-108 respectively in "machine readable medium." Inherently, the television program is received before it is recorded. It would have been obvious to embody the procedures of Croy as discussed with respect to claims 100- 108 in a "machine readable medium" in order that the instructions could be automatically performed by a processor.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allport (US 6,097,441) teaches system for dual display interaction with integrated television and internet content.

Darbee et al. (US 6,130,726) teaches program guide on a remote control display.


Yurt et al. (US 5,132,992) teaches audio and video transmission and receiving system.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh
June 23, 2004



VIVEK SRIVASTAVA
PRIMARY EXAMINER